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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,236	09/17/2001	Shinji Kobayashi	09812.0477-00000	8335
22852	7590	02/07/2006	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				HOLLOWAY III, EDWIN C
ART UNIT		PAPER NUMBER		
		2635		

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/955,236	KOBAYASHI, SHINJI
	<b>Examiner</b>	<b>Art Unit</b>
	Edwin C. Holloway, III	2635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 December 2005.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1 and 3-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1 and 3-10 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

Art Unit: 2635

***EXAMINER'S RESPONSE***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12-6-05 has been entered. The examiner has considered the new presentation of claims and applicant's arguments in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1 and 3-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borgstahl (US 5909183) in combination with Eisenhandler (US 5452291), Shteyn (6199136) and Humpleman (US 6198479).

Regarding claim 1, Borgstahl discloses a portable information device (remote control) 300 comprising:

Art Unit: 2635

initialization data transmitting means 300 for transmitting initialization data 326 to an access point; response data receiving means 300 for receiving response data 328 responsive to said initialization data from said access point; and operational information transmitting means 300 for transmitting information 334/340 used to operate a home appliance after said response data receiving means receive said response data. See figs. 20-21 and col. 16 line 15 - col. 17 line 17. Borgstahl differs from claim 1 by not expressly reciting the access point connected to a home network connected to home appliances, but does include peers connection to remote peer devices or appliance over a LAN via gateway interface 44 in fig. 1-2 and col. 5 lines 30-58. The gateway include protocol conversion in col. 6 lines 34-36.

Eisenhandler discloses an analogous art appliance control system where a portable remote control 90 controls appliances (50-56) connected to a home automation appliance LAN 80 using brouter 10 as an access point. This allows remote control of appliances in various locations of the home. See figs. 1-3 and col. 1 line 1 - col. 3 line 52 and col. 4 line 30 - col. 5 line 66.

Humpleman discloses a home network with HTTP server devices and URL addresses to provide browser based command and control.

Art Unit: 2635

The devices represent servers as stated in col. 5 lines 10-24 and col. 6 lines 40-46. The devices store html pages communicated as with HTTP/IP interface protocol in col. 6 lines 10-63 and are therefore HTTP servers that allow a custom GUI for devices from different manufacturers in col. 6 line 47 - col. 7 line 6. A bridge is included to communicate to different networks in col. 6 lines 19-33 and col. 5 lines 36-48. A DHCP discovery procedure to determine and negotiate addresses for devices is described starting at page 10 line 44 and may include URL addresses in col. 12 lines 54-67 and col. 13 lines 25-37.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Borgstahl connection of the access point to the appliance over a home network as disclosed in Eisenhandler to allow remote control of appliances in various locations of the home as suggested by Borgstahl disclosing connection of peers over a wired LAN using a gateway similar to the brouter of Eisenhandler.

Borgstahl discloses selecting an appliance address but does not expressly describe transmitting the address. Eisenhandler discloses a portable wireless device transmitting an address in col. 12 lines 9-28 in order to properly route the packet to a destination device. It would have been obvious to one of

Art Unit: 2635

ordinary skill in the art at the time the invention was made to have included in the combination applied above the operational information transmitting means transmit identity information used to identify the home appliance in view of Eisenhandler disclosing a portable device transmitting an address to properly route the packet to a destination device as suggested by Borgstahl disclosing selection of an address of a device to be controlled.

Regarding claim 3, Borgstahl includes a network interface 44 for accessing a LAN connected to devices or appliances to communicate with each of the appliances; a portable information device interface 38 for communicating with said portable information device; and control means 40/42 for doing a negotiation with said portable information device via said portable information device interface, whereby data are transmitted between said portable information device and each of said appliances through said portable information device interface and said network interface after the negotiation by the control means. Negotiation is disclosed in col. 9 lines 5-67, including relaying communication over a router or gateway to a remote device 34. A home network is not expressly recited in Borgstahl, but would have been obvious for the same reasons applied to claim 1 in view of the interfaces 14 and 16 of

Art Unit: 2635

Eisenhandler.

Regarding claim 4, said control means determine whether the data received from said portable information device interface are valid and further determine, when the data are valid, whether the data are an initialization packet, followed by creation of a new initialization packet when the data are an initialization packet, and outputting of the new initialization packet to said portable information device interface would have been obvious in view of the validation in col. 15 lines 16-25 of Eisenhandler in order to discard invalid packets and the initialization address search in col. 16 line 33 - col. 17 line 17 of Borgstahl.

Regarding claim 5, said control means analyzes data received from said portable information device and delivers the data to said network interface after a protocol conversion would have been obvious in view of the conversion in col. 7 line 58- col. 8 line 27 of Eisenhandler and suggested by the translation in col. 10 lines 25-40 of Borgstahl.

Regarding claim 6, said control means determine whether data received from said network interface are valid for accessing said portable information device, creating a transfer packet and outputting the transfer packet to said portable information device interface when the data are valid would have

Art Unit: 2635

been obvious for the same reasons applied above to claim 4.

Regarding claim 7, a home network system comprising; a home network for networking a plurality of home appliances; a portable information device connectable to said home network in a wireless manner; and an access point for reciprocal data communication between said home appliances connected to said home network and said portable information device, wherein said portable information device does negotiation to be served by said access point would have been obvious for the same reasons applied above to claims 4 and 6. Note that both Borgstahl and Eisenhandler include reciprocal data communication.

Regarding claim 8, said portable information device transmits to said access point the data used to select a home appliance from among a plurality of said home appliances after said negotiation would have been obvious for the reasons applied above to claim 2.

Regarding claim 9, a method for accessing a home network networking a plurality of home appliances, comprising: receiving from a portable wireless information device a request for accessing said home network; recognizing, upon receipt of the request for access, an address for designating a home appliance with which said portable wireless information device will communicate; and enabling exchange of data between the home

Art Unit: 2635

appliance designated by recognized said address and said portable wireless information device would have been obvious in view of the requests such as address search request 326, address acknowledge 328 and the exchange of data 334-342 in fig. 21 of Borgstahl in combination with the home network interface and portable device transmitting a destination address in Eisenhandler for the reasons applied above to claims 1-2.

Regarding claim 10, a method for accessing a home network networking a plurality of home appliances, comprising: transmitting a request for accessing said home network to an access point connected to said home network; transmitting address information used to designate a home appliance included in said home network after transmitting the request for access; and transmitting operational information used to operate said home appliance after transmitting said address information would have been obvious in view of the requests such as address search request 326, address acknowledge 328 and the transmitting of commands 334-342 in fig. 21 of Borgstahl in combination with the home network interface and portable device transmitting a destination address in Eisenhandler for the reasons applied above to claims 1-2.

Regarding the new language added to claims 1 and 3-10 by the 12-6-05 amendment, HTTP servers and URL addressing would

Art Unit: 2635

have been obvious in view of Humpleman to provide browser based GUI for devices from different manufacturers suggested by Borgstahl including selection by icon in col. 17 and internet protocol in col. 8. Humpleman does not expressly disclose a portable device, but such would have been obvious in view of Borgstahl disclosing a portable controller with display that may be a PDA. Humpleman disclosing in col. 18 lines 54-60 that any device connected to the home network with html display capability can act as a client (controller) and session server.

Regarding the language added to claims 1 and 3-10 by the 7-6-04 amendment, the examiner concedes that Borgstahl and Eisenhandler do not explicitly refer to high speed devices and low speed home appliances, but appliances are shown in fig. 3 of Borgstahl and fig. 3 of Eisenhandler that at least suggest the low speed home appliances. Further, fig. 3 of Borgstahl includes a computer that at least suggest a high speed device. Further, Borgstahl includes a gateway 44 and Eisenhandler includes brouter cluster controllers (BCC's) with bridging that at least suggest a bridge. Shteyn discloses a method and apparatus to provide interoperability between high data rate and low data rate networks. Shteyn includes a high data rate network with high data rate or high speed devices such as DTV and DVCR in col. 7 lines 60-62. Shteyn includes a slow data

Art Unit: 2635

rate network with low data rate or low speed devices/appliances 124,126,128 in col. 7 line 63 - col. 8 line 3, col. 8 lines 17-20 and col. 8 lines 45-51. A bridge between the high speed network 102 and low speed network 104 is included in col. 8 lines 43-45. Although the element 30 is identified, it is clear from fig. 1 that element 130 was intended. Shteyn also includes discovery by allowing devices to advertise their capabilities in col. 3 lines 50-66. Col. 5 lines 29-33 Shteyn discloses that the object is to merge a low bit rate home network with a high bit rate home network and to enable a HAVi system and low bit rate PC based home automation system to co-exist and enhance each other's functionalities. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in the combination applied above means and method to communicate to low speed appliances and high speed appliances through a bridging element as disclosed in Shteyn because Shteyn discloses that this allows one to merge a low bit rate home network with a high bit rate home network and to enable a HAVi system and low bit rate PC based home automation system to co-exist and enhance each other's functionalities and because Borgstahl and Eisenhandler suggest low/high speed appliances/devices and bridges/gateways.

Regarding limitations added by the 12-27-04 amendment and

Art Unit: 2635

modified by the 6-02-05 amendment, the exchanges of addresses and conversion of message formats, character codes, transmission rates and/or protocols would have been obvious in view of the translation and passing on of messages from network 102 to 104 in col. 8 lines 40-51 of Shteyn, where the networks 102 and 104 have different protocols and rates in col. 7 line 23 - col. 8 line 23. The combination is suggested by Shteyn disclosing advantages such as "cost-efficient control" and "synergistic aspects of the combination" in col. 8 lines 43-46 and Borgstahl disclosing use of protocol conversion devices known to those skilled in the art in col. 6 lines 34-36..

Regarding the limitations added by the 6-20-05 amendment, receiving from a portable wireless information device a request for accessing information used to designate home appliances and electronic devices included in said home network would have been at least suggested by the needs/capability message 64 in cols. 7-9, address search request 326 in col. 16, and/or controlled pings objects 356 in cols. 16-17 of Borgstahl. Bridge converting protocol is at least suggested by the protocol conversion in col. 6 lines 34-36 of Borgstahl and the conversion between networks in Shteyn discussed in the preceding paragraph.

**Response to Arguments**

4. Applicant's arguments with respect to claims 1 and 3-10

Art Unit: 2635

filed 12-6-05 have been considered but are moot in view of the new ground(s) of rejection.

The arguments that the prior art applied in the 35 USC 103 rejection of claims 1 and 3-10 lack the new HTTP and URL limitations is moot in view of the new rejection that adds the Humpleman patent as evidence that the new limitations would have been obvious.

#### **CONTACT INFORMATION**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact an Electronic Business Center (EBC) representatives at 703-305-3028 or toll free at 866-217-9197 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at [ebc@uspto.gov](mailto:ebc@uspto.gov). The Patent EBC is a complete customer service center that supports all Patent e-business products and service applications. Additional information is available on the Patent EBC Web site at <http://www.uspto.gov/ebc/index.html>.

Any inquiry of a general nature should be directed to the Technology Center 2600 receptionist at (571) 272-2600.

Facsimile submissions may be sent via central fax number 571-273-8300 to customer service for entry by technical support staff. Questions related to the operation of the facsimile system should be directed to the Electronic Business Center at (866) 217-9197. On July 15, 2005, the Central FAX Number will change to.

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Art Unit: 2635

claims in a regular U.S. patent application, and the reply to the examiner's Office action is desired to be transmitted by facsimile rather than mailed, the reply must be sent to the Central FAX Number. Inquiries concerning only hours and location of the Customer Window may be directed to OIPE Customer Service at (703) 308-1202.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (571) 272-3058. The examiner can normally be reached on M-F (8:30-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (571) 272-3068.

EH  
2/5/06

  
EDWIN C. HOLLOWAY, III  
PRIMARY EXAMINER  
ART UNIT 2635